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EXAMINER	
RETTA, YEHDEGA	
ART UNIT	PAPER NUMBER
3622	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/696,295	MORRISROE ET AL.	
	Examiner	Art Unit	
	Yehdega Retta	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on *21 July 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-28 and 31-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-28 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This office action is in response to amendments/remarks filed July 21, 2009. Claims 1-28 and 31-33 are still pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 7-10, 11, 12, 16, 18-21, 24-26 and 31-33 are rejected under 35 U.S.C. 102(b) as being anticipated by DoubleClick, as disclosed in DoubleClick International, 1/08/2001; (http://demo.doubleclick.com/generators/docs/designer_version.pdf) hereinafter DoubleClick.

Regarding claim 1, DoubleClick teach *combining at a server* an ad input file (Flash file, FLASH banner ads, FLASH movie) with a conduit file (click tracking string, ClickTag) to automatically create a single integrated ad file having a single file extension (swf file) *containing both the ad input file and the conduit file* (ActionScript used to combine the clicktag together with the movie); *wherein the conduit file comprises of computer code (*ClickTag) *for tracking data for the ad,* and serving the integrated ad file from a computer to provide the ad (see pp 1-3);

Regarding claim 4, DoubleClick teaches the use of Macromedia Flash; wherein the ad is Flash ad and the files are "swf" files (see pp 1-3)

Regarding claims 7-10, DoubleClick teaches the ad including one or more actions for linking to one or more web pages and wherein the ad input file specifies one or more button actions, each having an exit code ...; the integrated ad file includes html code loading a JavaScript file, for loading the integrated ad file; tracking the ad using the code in the conduit file and tracking identifier; the html code including a variable and the conduit file includes code that determined where the ad opens in a parent window or new window based on the variable (see pp 3).

Regarding claims 11, 12 and 24-26, DoubleClick teaches identifying a first file (Flash movie file); identifying a second file (tracking string (ClickTag)); wherein the first file specifies ad content code and the second file contains ad-tracking code; electronically inserting the second file into the first file to create a file having a single file extension (swf); wherein the first file specifies ad content code and the second file contains an ad-tracking code (see pp 1-3).

Regarding claims 16, 18-21, DoubleClick teaches identifying a first file (tracking string (ClickTag1); identifying a second file (tracking string (ClickTag2)); identifying a third file (Flash movie); identifying a first placeholder and second placeholder in the third file and electronically inserting the first and second file into the first and second placeholder respectively to create a single integrated ad file having a single file extension (swf); wherein the first file includes a tracking data; html code loading ad file (third file); third file including one or more buttons; wherein (see pp 1-3).

Regarding claims 31 and 32, DoubleClick teaches the integrated ad file includes one or more exit code referring to one or more URL variables; wherein the integrated ad file is designed to be loaded and wherein the ad is provided (see pp 2-3).

Regarding claim 33, DoubleClick teaches the ad is provided to a user computer via the Internet and combining of the files is in response to receiving a request for a Web page and serving the integrated ad file as par of the web page (see pp 2&3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 2, 3, 5, 6, 13, 15, 17, 22, 23, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over DoubleClick, as applied to claim 1 above, in view of Official Notice.

Regarding claims 2, 3, 13, 14, 22, 23 and 28, DoubleClick teaches each time the destination URL has to be modified (for whatever reason) the FLASH file has to be sent back to the design agency to be modified. DoubleClick also teaches by using variables to pass the click tracking string into Flash movies instead of modifying the FLASH file itself only the variable in the Rich Media Field is changed. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to known that the designer or programmers of DoubleClick would accept a new or modified information or content from the source and insert the same or different tracking information according to the goals of the campaign or the preference of the tracking server.

Regarding claims 5 and 6, DoubleClick teaches Flash Movie (swf file) but does not explicitly teaches the file includes an empty movie object and inserting the conduit file in the

empty movie object; wherein the empty movie clip is given a predefined name and searching for the predefined name. *However official notice is taken that old and well known in the art of Macromedia Flash to create an empty movie clip using Macromedia Flash, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it.* Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the empty clip as a placeholder for external file such as the tracking data, if the ad is a movie clip.

Regarding claims 15, 17 and 27, DoubleClick does not explicitly teach identifying a placeholder (an empty movie clip) in the first file and electronically inserting the second file in the placeholder to create an ad file. *However official notice is taken that is old and well known in the art of programming to create empty movie clip using Macromedia Flash. Macromedia Flash is used to create an empty movie clip, one that contains no data or graphic content, so that external files (JPGS or SWF) can be loaded into it.* Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to create an empty movie clip, in rich media, as a placeholder for external files such as the tracking data to be inserted, if the ad is a movie clip.

Response to Arguments

Applicant's arguments filed July 21, 2009 have been fully considered but they are not persuasive.

Applicant asserts that the input file identifies the contents of the ad and the conduit file contains computer code for identifying tracking data for the ad, and the single integrated file contains both the ad input file and the conduit file and is served from the server to provide the ad. Applicant argues that DoubleClick does not disclose or suggest a conduit file and does not

disclose or suggest a conduit file that is automatically combined with an ad input file by a merge tool to create an integrated ad file. Applicant also argues that the DoubleClick's click tracking string and ClickTag do not correspond to the claimed conduit file … at least based on the fact that neither one of them is a file. Applicant asserts that Doubleclick's Click tag is an expression, not a file …

Applicant's specification discloses (page 6) that the integrated ad file reflects the integration or combination of two separate files; an ad input file, primarily including the contents of the ad and a conduit file, *primarily including code used in tracking the ad*. The specification further discloses (page 9) that the operations performed by the portal (e.g. an administrator 108) in creating the integrated ad file 204 to be served via the ad server; the portal 100 uses the merge tool 502 to combine the contents of the ad input file 504 provided by the advertiser with the contents of the conduit file 506 created by the portal; Applicant's specification teaches that the ad input file 504 contains the content of the ad, as provided by the advertiser, and the ***conduit file*** contains *code for tracking the ad*. Further the specification discloses that the merge tool replaces an empty movie clip object in the ad input file with the conduit file 506 … It is also discloses (page 12) that the conduit file provides *actionScript for tracking the ad and for determining whether the ad opens in the same window* in which the html code 202 is embedded or in a new window. It is also disclosed that to determine whether or not the ad should be opened in new or the same window the conduit file includes the "if" statement to determine based on the value of targID variable in the html code ... when the ActionScript from the conduit file when merged into the integrated ad file 204 … on page 14 it is disclosed that *the conduit file 504 also includes an optional unique identifier*.

The claim however recites wherein the **conduit file** *comprises of computer code to identify tracking data for the ad*. The claim does not recite any information, beside the tracing code, included in the conduit file.

DoubleClick, same as applicant's invention, uses variable to pass the click tracking string into Flash movies, instead of modifying the Flash file itself (see page 1). Doubleclick also teaches that the clickTag used to pass the click tracking information and ***ActionScript is used to combine the ClickTag together with the movie*** (see page 2). DoubleClick teaches the click tracking string allows advertisers to know how many times a user has clicked on their Flash banner and to direct them to the destination URL. DoubleClick also teaches a "file" which includes a click tracking string (ClickTag), a destination URL and also a target window (by setting the target to _blank) (see fig.2 on page 3). Therefore, if the conduit file includes more than the tracking code, Doubelclick same as applicant's disclosure also teaches a file that includes more than just the tracking code (destination URL and target window).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding claims 2 and 3, Applicant argues that DoubleClick does not teach or suggest combining a modified input file with a conduit file or combining a modified conduit file with an input file to create a modified single integrated ad file. Examiner respectively disagrees. DoubleClick teaches that previously the click tracking string had to be embedded into the Flash movies (swf file) as a click command; the problem with this old method is that each time the destination URL has to be modified (for what ever reason) the Flash File has to be sent back to

the design agency to be modified... as a result instead of modifying the FLASH File itself, we will only change the variable in the Rich media File. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to know that DoubleClick would also accept a modified ad file or a modified conduit file to be integrated into a single file, if the advertiser decided to modifies the original ad file, instead of submitting a newly created ad file, or change the tracking code in the conduit file, instead of submitting a new conduit file, since the original ad file or conduit file can be changed, modified or edited.

Regarding claims 5 and 6, Applicant requests that the Examiner provides evidentiary support for the "Officially Noticed" facts. Such bald statement is not adequate and do not shift the burden to the Examiner to provide evidence in support of the Official Notice. Allowing such statements to challenge Official Notice would effectively destroy any incentive on the part of the examiner to use it in the process of establishing a rejection of well known facts. Therefore, the presentation of a reference to substantiate the Official Notice is not deemed necessary. The Examiner's taking of Official Notice has been maintained.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Macromedia Flash 5, Quick Reference Card, Custom Guide, Your Organization's personal Trainer.

YAHOO! Flash Banner Ads.

Colin Moock, ActionScript: The Definitive Guide: Chapter 13:Movie Clip; O'Reilly, Online Catalog, May 2001.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (571) 272-6723. The examiner can normally be reached on 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

YR

/Yehdega Retta/
Primary Examiner, Art Unit 3622